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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/646,954	05/08/96	MACOR R	IDEW056

RICHARD J MACOR
2151 NEW VILLAGE ROAD
STEWARTSVILLE NJ 08886

C2M1/1208

EXAMINER

DANGANAN, J

ART UNIT

PAPER NUMBER

3203

DATE MAILED: 12/08/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/646,954

Applicant(s)
Richard J. Macor

Examiner
Joni Danganan

Group Art Unit
3203



☒ Responsive to communication(s) filed on Sep 19, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-31 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Applicant is advised that should Claim 13 be found allowable, Claim 16 will be rejected under 35 U.S.C. 101 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to reject the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

2. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-10 and 31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 21-24 and 29-31 of copending Application No. 08/500,178 in view of Lawrie '849. Lawrie teaches that it is known in the art to form an outer tool-encircling member (10) such that the ends (34,42) of the inner cavity have a

dimension greater than a dimension of a central part of the cavity. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the grip member of Application No. 08/500,178 by forming the ends of the cavity with a dimension greater than that of the central part as taught by Lawrie in order to minimize the surface area of the grip which would come into contact with the head of the tool.

This is a provisional obviousness-type double patenting rejection.

4. Claims 11-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 21-24 and 29-31 of copending Application No. 08/500,178 in view of Stroop '475. Stroop teaches that it is known in the art to form a gripping means with both an inner member (15) and an outer member (19) in order to provide for affording handgrips of adjustable widths to accommodate various individuals (see abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the gripping means of Application No. 08/500,178 by including an inner and an outer member as taught by Stroop in order to provide for affording handgrips of adjustable widths to accommodate various individuals.

This is a provisional obviousness-type double patenting rejection.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-4, 6-9 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills '188 in view of Lawrie '849.

Mills discloses a double-ended wrench (12) and a movable wrench grip (20) (see Fig. 5) which may be positioned at either end of the double ended wrench and whereby movement of the grip (20) is confined by the two wrench heads. As seen in Fig. 1, the width of each wrench head is greater than the width of the handle, and the width of the cavity of the wrench grip (20) is less than the width of the wrench heads. However, Mills does not disclose at least one end of the grip cavity having a dimension greater than that of a central part of the cavity. Lawrie teaches that it is known in the art to form an outer tool-encircling member (10) such that the ends (34,42) of the inner cavity have a dimension greater than a dimension of a central part of the cavity. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the grip member of Mills by forming the ends of the cavity with a dimension greater than that of the central part as taught by Lawrie in order to minimize the

surface area of the grip which would come into contact with the head of the tool.

In regard to Claims 2 and 7, the grip (20) of Mills is frictionally engaged with the wrench (12) thereby temporarily fixing the grip (20) on the wrench (12).

In regard to Claims 3, 4, 8 and 9, Fig. 5 shows that the movable wrench grip (20) includes at least one seam (21) extending the entire length thereof to facilitate attachment and detachment of the grip (20) with the wrench (12).

7. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills '188 in view of Lawrie '849 as applied above, and further in view of Distiso '530.

Mills in view of Lawrie has been discussed above but does not disclose a wrench grip comprised of two separate interconnecting parts. Distiso teaches that it is known to form a handle/grip from two halves (34,36) having mating edges (38,42) with a plurality of couplers (40,44) for connecting the two halves as set forth in column 2, lines 43-51. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Mills by forming the wrench grip (20) from two interconnecting parts as taught by Distiso in order to better facilitate placement of the grip around the handle.

8. Claims 11-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills '188 in view of Stroop '475.

Mills discloses a double-ended wrench (12) and a movable wrench grip (20) (see Fig. 5) which may be positioned at either end of the double ended wrench and whereby movement of the grip (20) is confined by the two wrench heads. As seen in Fig. 1, the width of each wrench head is greater than the width of the handle, and the width of the cavity of the wrench grip (20) is less than the width of the wrench heads. However, Mills does not disclose the grip comprising an inner member and an outer member. Stroop teaches that it is known in the art to form a gripping means with both an inner member (15) and an outer member (19) in order to provide for affording handgrips of adjustable widths to accommodate various individuals (see abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the gripping means of Mills by providing an outer member as taught by Stroop in order to provide for affording handgrips of adjustable widths to accommodate various individuals.

In regard to Claims 12 and 22, the grip (20) of Mills is frictionally engaged with the wrench (12) thereby temporarily fixing the grip (20) on the wrench (12).

In regard to Claims 13, 16, 23 and 26, Fig. 5 shows that the movable wrench grip (20) includes at least one seam (21) extending the entire length thereof to facilitate attachment and detachment of the grip (20) with the wrench (12).

In regard to Claims 14, 17, 19, 24, 27 and 29, Stroop teaches that it is known to form the outer member (19) substantially elastic and continuous (see Fig. 3 and column 3, lines 57-59).

Regarding Claims 15, 18, 20, 25, 28 and 30, column 4, lines 27-35 of Stroop state that variations in size, materials, shape, and form of the adjustable handgrip are readily apparent and obvious to one of ordinary skill in the art. Therefore, forming the outer grip member of any particular length relative to the inner grip member would have been obvious to one of ordinary skill in the art.

9. Applicant's arguments filed 9-19-97 have been fully considered but they are not persuasive.

In regard to the possible 35 U.S.C. 101 rejection of Claim 13 or 16, applicant states that a terminal disclaimer will be filed when appropriate. However, a terminal disclaimer will **NOT** overcome 35 U.S.C. 101 rejection. Applicant should delete either Claim 13 or Claim 16.

Applicant argues that since the wrench and wrench grip of Mills are in different drawings, the exact relationship of their combination is assumed by the examiner. Clearly, anyone of ordinary skill in the art would conclude that it is implied that the attachment of Fig. 5 of Mills is to be used with a double-ended wrench as shown in Fig. 1 as disclosed by the Mills reference **as a whole**.

Regarding the movable gripping means, applicant argues that the embodiment in Fig. 5 of Mills does not disclose a movable grip. The examiner disagrees. Mills does, in fact, disclose a movable grip in Fig. 5. An objective of Mills is "to provide a device which may easily be attached or removed from an open-end wrench" (column 1, lines 39-41). Clearly, since the grip (20) of Mills is not fastened to the wrench and is easily removed, the grip is engaged "for movement" along the wrench. Mills does not disclose the grip as *fixedly* secure or permanently attached to the wrench; therefore, the grip is "movable" along the wrench. Additionally, applicant merely recites a gripping means that is "positionable at each end of said elongated handle." Clearly, Mills discloses a wrench grip that may be initially "positioned" at a first end of the elongated handle; removed; and then "positioned" at a second end of the elongated handle.

In response to applicant's argument that Lawrie teaches the recited gripping means cavity for minimizing the surface area which would come in contact with the inner member, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Furthermore, the use of a particularly shaped inner cavity for a different purpose does **not** alter the conclusion that its use

in a prior art device would be *prima facie* obvious from the purpose disclosed in the reference. *In re Lintner*, 173 USPQ 560.

Applicant argues that Lawrie does not disclose one element of the present invention, namely a double-ended wrench or a gripping means. The examiner disagrees. Broadly interpreted, Lawrie teaches a gripping means (10). Furthermore, *Mills* was relied upon for disclosing the double-ended wrench and gripping means. *Lawrie* was relied upon for its *general* teaching of an outer tool-encircling member (10) such that the ends (34,42) of the inner cavity have a dimension greater than a dimension of a central part of the cavity.

Applicant remarks that the Distiso reference is directed to a toothbrush and not a wrench. The examiner acknowledges this limitation; however, the Distiso reference was used for its *general* teaching of a two-part handle and not the toothbrush. Clearly, Distiso discloses that it is known to form a single handle from two parts connected together. In response to applicant's argument that there is no suggestion to combine the Mills and Distiso references, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of

disclosures taken as a whole would suggest to one of ordinary skill in the art. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In this case, Mills discloses a double-ended wrench with a unitary handle grip, and Distiso discloses a single handle formed from two separate parts. Clearly, from the combined teachings of Mills and Distiso it would have been obvious to one of ordinary skill in the art to have modified Mills by forming the handle grip from two separate parts.

In response to applicant's argument that Stroop teaches a gripping means comprising an inner member and an outer member for affording grips of adjustable widths, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Furthermore, the use of a gripping means with both inner and outer members for a different purpose does **not** alter the conclusion that its use in a prior art device would be *prima facie* obvious from the purpose disclosed in the reference. *In re Lintner*, 173 USPQ 560.

In response to applicant's question of the examiner's comprehension of the present invention, the examiner **fully** understands the present invention. Although the applicant questions the usage of cited references applied to the claims and

the motivation to combine these references, as thoroughly addressed above, the cited combination of references discloses the claimed invention.

Applicant erroneously assumes the patentability of Claim 31. Applicant states that Claim 31 recites a gripping means "shorter than" the elongated handle counter to Mills' grip which is "as long as" the elongated handle. However, Mills states that the grip "**may** be as long as" the handle. Therefore, it is obvious to conclude that the grip may be *shorter* than the handle. Regarding the "substantial movement", "substantial" is a relative term and the grip of Mills has "substantial" movement on the handle. Regarding the grip being positionable "without being removed", it has been held that the functional "whereby" statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957). In regard to the cavity having one end "adapted to accommodate" one neck area, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Serial Number: 08/646,954
Art Unit: 3203

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A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joni Danganan whose telephone number is (703) 305-5930.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

jbd

December 6, 1997


D.S. MEISLIN
PRIMARY EXAMINER
GROUP 320-ART UNIT 323